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EXAMINER
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NEURAUTER, GEORGE C

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2143

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,812

Applicant(s)

CHU ET AL.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/04/05, 09/23/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Claims 1-49 are currently presented and have been examined.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 14-19, 30-31, 41, and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 9 recites the limitation "...prior to [the] second client initially accessing said website, said second client registers with said website..." This limitation is not described in the specification in order to enable one of ordinary skill in the art to make and/or use the invention.

Claims 14-19 recite the limitation "default file transfer interface". This limitation is not described in the

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specification in order to enable one of ordinary skill in the art to make and/or use the invention.

Claims 30 and 31 recite the limitation "return link". This limitation is not described in the specification in order to enable one of ordinary skill in the art to make and/or use the invention.

Claims 41 and 43 recite the limitation "interface of [a] client software". This limitation is not described in the specification in order to enable one of ordinary skill in the art to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "...wherein [the] first client issues [the] instructions via a website for accessing [the] server." It is not clear as to where the website exists.

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In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret this limitation wherein the website exists on the server. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claim 2 recites the limitation "...first embedded client software for uploading said file is automatically downloaded to [the] first client." It is not clear as to where the file to be automatically downloaded originates.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret this limitation wherein the file originates from the server. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claim 4 recites the limitation "issuing second instructions to for notifying a second client...". It is not clear as to where the second instructions are issued from and wherein the second instructions are issued to.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret this limitation wherein the server notifies the second client. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

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Claim 5 recites the limitation "...wherein [the] second instructions are forwarded to [the] server via a third client". It is not clear as to how the third client is functionally involved in the steps of the claimed method, specifically how the third client acquires the second instructions to be forwarded to the server.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret the limitation wherein the second instructions are forwarded to the server via the first client. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claim 9 recites the limitation "issuing second instructions for transferring [the] file to a second server". It is not clear as to where the second instructions are issued from and where the file to be transferred is transferred from and where the file is to be transferred.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret the limitation as the second instructions are issued from the first client and the file is transferred from a second server to the second client. See,

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e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claim 10 recites the limitation "...issuing second instructions for transferring said file to a second server". It is not clear as to how the second server is functionally involved in the steps of the claimed invention since the claimed second server does not functionally operate upon the received second instructions.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret the limitation wherein the second instructions are issued to the first server. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claim 13 recites the limitation "...prior to second client initially accessing said website, said second client registers with said website creating a second account for said second client". It is not clear as to how the second client registers with said website before initially accessing the web site.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret the limitation as the second client registers with the website prior to accessing the website in

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order to receive a file. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claim 20 recites the limitation "said second client software monitors the status of said second account to determine if a file is available for downloading from said server." In view of claim 4, which depends from claim 20, it is not clear as to how the client receives notification that a file is available since the monitoring of the status of a second account and receiving second instructions both notify the client and appear to the Examiner to be mutually exclusive to one another for the purposes of notifying.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will interpret the limitation as the second client monitoring the status of the second client's account in lieu of receiving the second instructions. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claims 30 and 31 recite the limitation "said second webpage". There is insufficient antecedent basis for this limitation in the claim.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will assume that claims 30 and 31 depend from claim 29



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which would provide sufficient antecedent basis from the claim. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

### ***Claim Interpretation***

The Applicant has not provided a clear definition for the terms "return link", "default file transfer interface", "interface of [a] client software" recited in claims 14-19, 30-31, and 41, and 43 within the specification. Therefore, the Examiner will interpret these elements by their plain meaning as if the terms were interpreted by one of ordinary skill in the art. See MPEP § 2111.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 10-12, 14-16, and 32 are rejected under 35 U.S.C. 102(a) as being anticipated by "Filesanywhere Getting Started Guide" ("Getting Started").

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Regarding claim 1, "Getting Started" discloses a method of securely transferring a file from a first client to a second client comprising issuing instructions from said first client to a server for transferring a file from said server to said second client, wherein said first client issues said instructions via a website for accessing said server. (page 4, "Sending Files to other Filesanywhere Users or Email Users", specifically "First select a remote file on the left you wish to send. Click Send Files to view the sending options...E-Send any remote file or local file to other FilesAnywhere users.")

Regarding claim 2, "Getting Started" discloses the method according to claim 1, wherein prior to issuing said instructions, said method includes issuing initial instructions for uploading said file from said first client to said server and wherein upon said first client initially accessing said website, first embedded client software for uploading said file is automatically downloaded to said first client. (page 1, "Login to FilesAnywhere. You will see the Main View"; page 3, "Uploading Files to Your FilesAnywhere Drive...When done choosing local files, press the "Upload" button to transfer copies of the files you chose to the FilesAnywhere remote folder...")

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Regarding claim 3, "Getting Started" discloses the method according to claim 2, wherein said initial instructions are issued if said file does not exist on said server. (page 3, "Uploading Files to Your FilesAnywhere Drive...When done choosing local files, press the "Upload" button to transfer copies of the files you chose to the FilesAnywhere remote folder...")

Regarding claim 10, "Getting Started" discloses the method according to claim 1, further comprising issuing second instructions for transferring said file to a second server. (page 3, "Uploading Files to Your FilesAnywhere Drive...When done choosing local files, press the "Upload" button to transfer copies of the files you chose to the FilesAnywhere remote folder...")

Regarding claim 11, "Getting Started" discloses the method according to claim 1, wherein either or both of said first client and said second client comprises a computer. (page 2, specifically "Follow these steps to copy files from any local computer you are using...")

Regarding claim 12, "Getting Started" discloses the method according to claim 1, wherein prior to issuing said instructions, said first client registers with said server website creating a first account for said first client. (page 1,

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"Create a New Account...You'll be online using FilesAnywhere in just a couple of minutes.")

Regarding claim 14, "Getting Started" discloses the method according to claim 2, wherein said first client specifies a default file transfer interface. (page 2, "Main View")

Regarding claim 15, "Getting Started" discloses the method according to claim 14, wherein said default file transfer interface comprises a network-based interface. (page 2, "Main View")

Regarding claim 16, "Getting Started" discloses the method according to claim 14, wherein said default file transfer interface comprises a resident interface of said first client software. (page 2, "Main View")

Regarding claim 32, "Getting Started" discloses the method according to claim 1, wherein software resident on said server tracks said file transfer. (page 3, specifically "The 'Uploading' progress page appears and will remain open until the file transfer is completed...")

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by "Hotmail Frequently Asked Questions" ("Hotmail").

Regarding claim 1, "Hotmail" discloses a method of securely transferring a file from a first client to a second client comprising issuing instructions from said first client to a

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server for transferring a file from said server to said second client, wherein said first client issues said instructions via a website for accessing said server. (page 1, specifically "Sending and receiving Email using Hotmail is as easy as browsing to the Hotmail Web site (<http://207.82.250.8>), logging on and sending an Email message")

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 4-9, 13, 17-22, 25, 28-31, 40-43, and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Getting Started" in view of "Introducing Filesanywhere" ("Filesanywhere").

Regarding claim 4, "Getting Started" discloses the method according to claim 1.

"Getting Started" does not expressly disclose further comprising issuing second instructions to for notifying said second client that said file is available for downloading from said server, however, "Filesanywhere" does disclose these limitations (pages 4 and 5, "What Else Can I Do Beyond Saving and Opening Files?", specifically "Custom E-Send messages can

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accompany files and these appear in a user's Inbox, just like Email") (see also in "Getting Started", page 2, "Filesanywhere Main View", specifically "Remote File Folders" and "Inbox")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references because one of ordinary skill in the art would have been motivated to combine the teachings of the references based on the specific references to each other regarding the "Filesanywhere" invention, which would also lead one of ordinary skill in the art to reasonably expect a successful combination of the teachings of the references.

Regarding claim 5, "Getting Started" and "Filesanywhere" disclose the method according to claim 4.

"Getting Started" does not disclose wherein said second instructions are forwarded to said server via a third client, however, "Filesanywhere" does disclose this limitation (page 5, specifically "Now you can use E-Link to email your friends a temporary URL link to your saved files at FilesAnywhere.").

Claim 5 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 5.

Regarding claim 6, "Getting Started" and "Filesanywhere" disclose the method according to claim 5.

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"Getting Started" discloses wherein said third client comprises any one of a desktop computer, a laptop computer, a phone, and a wireless device. (page 2, specifically "Follow these steps to copy files from any local computer you are using...")

Regarding claim 7, "Getting Started" and "Filesanywhere" disclose the method according to claim 4.

"Getting Started" does not disclose wherein said notifying comprises at least one of a visual indicator, a audio indicator, and/or an email message, however, "Filesanywhere" does disclose this limitation (page 5, specifically "Now you can use E-Link to email your friends a temporary URL link to your saved files at FilesAnywhere,").

Claim 7 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 7.

Regarding claim 8, "Getting Started" and "Filesanywhere" discloses the method according to claim 4.

"Getting Started" does not expressly disclose further comprising downloading said file to said second client, however, "Filesanywhere" does disclose this limitation (page 5, specifically "They simply click on the e-Link displayed within the body of the email message to start the download").



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Claim 5 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 5.

Regarding claim 9, "Getting Started" and "Filesanywhere" disclose the method according to claim 8.

"Getting Started" discloses the method further comprising automatically downloading second embedded client software upon said second client initially accessing said website. (page 1, "Login to FilesAnywhere. You will see the Main View")

Regarding claim 13, "Getting Started" and "Filesanywhere" disclose the method according to claim 9.

"Getting Started" discloses wherein prior to said second client initially accessing said website, said second client registers with said website creating a second account for said second client. (page 1, "Create a New Account...You'll be online using FileAnywhere in just a couple of minutes.")

Regarding claim 17, "Getting Started" and "Filesanywhere" disclose the method according to claim 13.

"Getting Started" discloses wherein said second client specifies a default file transfer interface. (page 2, "Main View")

Regarding claim 18, "Getting Started" and "Filesanywhere" disclose the method according to claim 17.

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"Getting Started" discloses wherein said default file transfer interface comprises a network-based interface. (page 2, "Main View")

Regarding claim 19, "Getting Started" and "Filesanywhere" discloses the method according to claim 17.

"Getting Started" discloses wherein said default file transfer interface comprises a resident interface of said second client software. (page 2, "Main View")

Regarding claim 20, "Getting Started" and "Filesanywhere" disclose the method according to claim 19.

"Getting Started" does not expressly disclose wherein said second client software monitors the status of said second account to determine if a file is available for downloading from said server, however, "Getting Started" does disclose the second client software which indicates the status of the second account (page 2, "Main View", specifically "Remote File Folders" and "Inbox")

"Filesanywhere" discloses wherein said second client software monitors the status of said second account to determine if a file is available for downloading from said server. (pages 4 and 5, "What Else Can I Do Beyond Saving and Opening Files?", specifically "Custom E-Send messages can accompany files and these appear in a user's Inbox, just like Email")

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Claim 20 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 20.

Regarding claim 21, "Getting Started" and "Filesanywhere" disclose the method according to claim 20.

"Getting Started" does not expressly disclose wherein said second client software indicates that a file is available for transfer to said second client from said server, however, however, "Getting Started" does disclose the second client software which indicates the status of the second account. (page 2, "Main View", specifically "Remote File Folders" and "Inbox")

"Filesanywhere" does disclose wherein said second client software indicates that a file is available for transfer to said second client from said server. (pages 4 and 5, "What Else Can I Do Beyond Saving and Opening Files?", specifically "Custom E-Send messages can accompany files and these appear in a user's Inbox, just like Email")

Claim 21 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 21.

Regarding claim 22, "Getting Started" and "Filesanywhere" disclose the method according to claim 21.

"Getting Started" does not expressly disclose wherein said second client software indicates by at least one of a visual indicator, an audio indicator, a vibratory indicator, and/or an

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email message, however, however, "Getting Started" does disclose the second client software which indicates the status of the second account. (page 2, "Main View", specifically "Remote File Folders" and "Inbox")

"Filesanywhere" discloses wherein said second client software indicates by at least one of a visual indicator, an audio indicator, a vibratory indicator. (pages 4 and 5, "What Else Can I Do Beyond Saving and Opening Files?", specifically "Custom E-Send messages can accompany files and these appear in a user's Inbox, just like Email")

Claim 22 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 22.

Regarding claim 25, "Getting Started" discloses the method according to claim 1.

"Getting Started" does not expressly disclose wherein communications between said first client and said server and/or between said second client and said server and/or between said server and a second server are encrypted, however, "FilesAnywhere" does disclose this limitation (page 6, specifically "We do offer a special SSL login and file transfer service which provides highly encrypted logins and file transfers.").

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Claim 25 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 25.

Regarding claim 28, "Getting Started" and "Filesanywhere" disclose the method according to claim 22.

"Getting Started" and "Filesanywhere" do not expressly disclose wherein said email message includes a first link to a webpage of said server, however, "Filesanywhere" does disclose wherein said email message includes a first link to a file at the server (page 5, specifically "Now you can use e-Link to email your friends a temporary URL link to your saved files at FilesAnywhere).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of these references since "Filesanywhere" suggests that a link may be used to access the server (page 5, specifically "Now you can use e-Link to email your friends a temporary URL link to your saved files at FilesAnywhere...they simply click on the e-Link displayed within the body of the email message to start the download.")). In view of these teachings and suggestions and wherein accessing a website at a server using a link is within the knowledge of one of ordinary skill in the art, one of ordinary skill would have found it obvious to modify the

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references so that the link in the email is used to access a webpage in order to access the server.

Regarding claim 29, "Getting Started" and "Filesanywhere" disclose the method according to claim 28.

"Getting Started" and "Filesanywhere" do not expressly disclose wherein said webpage includes a second link to a second webpage for downloading said file, however, "Filesanywhere" discloses wherein a link to a file causes the file to be downloaded (page 5, specifically "Now you can use e-Link to email your friends a temporary URL link to your saved files at FilesAnywhere...they simply click on the e-Link displayed within the body of the email message to start the download.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of these references since "Filesanywhere" suggests that a link may be used to access the server in order to download a file (page 5, specifically "Now you can use e-Link to email your friends a temporary URL link to your saved files at FilesAnywhere...they simply click on the e-Link displayed within the body of the email message to start the download."). In view of these suggestions and teachings shown above and wherein accessing a website at a server using a link to download a file is within the knowledge of one of ordinary skill in the art, one

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of ordinary skill would have found it obvious to modify the references so that a second link in a webpage linked by the first link would be used to access a webpage in order to download a file.

Regarding claim 30, "Getting Started" and "Filesanywhere" disclose the method according to claim 29, as assumed by the Examiner above.

"Getting Started" and "Filesanywhere" do not expressly disclose wherein said second webpage includes a return link for uploading said downloaded file to said server, however, "Getting Started" does disclose wherein a webpage includes a return link for uploading a downloaded file to said server (page 2, "Main View", specifically "Upload Local File"; page 3, the section "Uploading Files to Your FilesAnywhere Drive", specifically "First press the top "Browse" button")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of these references since "Getting Started" suggests that a webpage may be used includes a return link for uploading said downloaded file to said server. In view of these suggestions and teachings shown above and wherein accessing a website at a server using a link to download a file is within the knowledge of one of ordinary skill in the art, one of ordinary skill would

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have found it obvious to modify the references so the second webpage includes a return link for uploading the downloaded file to the server to allow the second client to upload the downloaded file.

Regarding claim 31, "Getting Started" and "Filesanywhere" disclose the method according to claim 29, as assumed by the Examiner.

"Getting Started" and "Filesanywhere" do not expressly disclose wherein said second webpage includes a return link for returning said downloaded file to said first client, however, "Getting Started" does disclose wherein a webpage includes a return link for returning a downloaded file to the first client (page 2, "Main View", specifically "Upload Local File"; page 3, the section "Uploading Files to Your FilesAnywhere Drive", specifically "First press the top "Browse" button"; page 4, "Sending Files to other FilesAnywhere Users or Email Users", specifically "First select a remote file on the left you wish to send...")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of these references since "Getting Started" suggests that a webpage may be used includes a return link for returning a downloaded file to the first client. In view of these



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suggestions and teachings shown above and wherein accessing a website at a server using a link to download a file is within the knowledge of one of ordinary skill in the art, one of ordinary skill would have found it obvious to modify the references so the second webpage includes a return link for returning the downloaded file to the first client to allow the second client to return the downloaded file to the first client.

Regarding claim 40, "Getting Started" discloses a method of transferring a file from a first client to a second client comprising:

issuing first instructions from said first client to register an account with a server via a website for transferring a file said second client, wherein said first client includes a web browser for accessing said website; (page 1, "Create a New Account...You'll be online using FilesAnywhere in just a couple of minutes.") and

issuing second instructions for uploading said file to said server via said website and wherein upon said first client initially accessing said website, embedded client software for uploading said file is automatically downloaded to said first client; (page 1, "Login to FilesAnywhere. You will see the Main View"; page 3, "Uploading Files to Your FilesAnywhere Drive...When done choosing local files, press the "Upload"

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button to transfer copies of the files you chose to the FilesAnywhere remote folder..."

"Getting Started" does not expressly disclose notifying said second client that said file is available for downloading from said website or connecting said second client to said server via said website for downloading said file, wherein said second client includes a web browser for accessing said website and downloading said file, however, "Filesanywhere" does disclose these limitations (pages 4 and 5, "What Else Can I Do Beyond Saving and Opening Files?", specifically "Custom E-Send messages can accompany files and these appear in a user's Inbox, just like Email") (see also in "Getting Started", page 2, "Filesanywhere Main View", specifically "Remote File Folders" and "Inbox") (page 5, specifically "They simply click on the e-Link displayed within the body of the email message to start the download")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references because one of ordinary skill in the art would have been motivated to combine the teachings of the references based on the specific references to each other regarding the "Filesanywhere" invention, which would also lead

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one of ordinary skill in the art to reasonably expect a successful combination of the teachings of the references.

Claims 46 and 48 are also rejected since claims 46 and 48 recite a system and computer executable instructions on a computer readable media that contain substantially the same limitations as recited in claim 40.

Regarding claim 41, "Getting Started" and "Filesanywhere" disclose the method according to claim 40.

"Getting Started" discloses wherein subsequent access to said server by said first client is through an interface of said client software. (page 2, "Main View")

Regarding claim 42, "Getting Started" and "Filesanywhere" disclose the method according to claim 40.

"Getting Started" does not expressly disclose wherein upon said second client initially accessing said website, embedded second client software for downloading said file is automatically downloaded to said second client, however, "Filesanywhere" does disclose this limitation (page 1, "Login to FilesAnywhere. You will see the Main View").

Claim 42 is rejected since the motivations regarding the obviousness of claim 40 also apply to claim 42.

Regarding claim 43, "Getting Started" and "Filesanywhere" disclose the method according to claim 42.

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"Getting Started" discloses wherein subsequent access to said server by said second client is through an interface of said second client software. (page 2, the element "Main View")

Claims 47 and 49 are also rejected since claims 47 and 49 recite a system and computer executable instructions on a computer readable media that contain substantially the same limitations as recited in claim 9.

1. Claims 26, 27, 33-36, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Getting Started" in view of Official Notice.

Regarding claim 26, "Getting Started" discloses the method according to claim 1.

"Getting Started" discloses wherein software resident in said server logs said issued instructions for transferring said file. (page 4, "Sending Files to other Filesanywhere Users or Email Users", specifically "First select a remote file on the left you wish to send. Click Send Files to view the sending options...")

"Getting Started" does not expressly disclose logging said issued instructions into a database.

Examiner takes Official Notice (see MPEP § 2144.03) that using a database to store information in a server was well known in the art at the time the invention was made. The Applicant is

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entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Regarding claim 27, "Getting Started" discloses the method according to claim 1.

"Getting Started" does not expressly disclose wherein said file is transferred from said first client to said server and/or from said server to said second client and/or from said server

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to a second server via TCP/IP protocol, however, "Getting Started" does disclose wherein the file is transferred via the Internet (page 1, specifically "Now you can really leverage the Internet to store your own files...and send big files to others over the Web).

Examiner takes Official Notice (see MPEP § 2144.03) that transferring a file using the TCP/IP protocol in an Internet system was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that

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37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Regarding claim 33, "Getting Started" and Official Notice disclose the method according to claim 26.

"Getting Started" does not expressly disclose wherein said database includes at least one of account information, file package information, second client addresses, server site information, server list information, upload information and download information, however, "Getting Started" does disclose wherein said server store includes at least one of account information, file package information, second client addresses, server site information, server list information, upload information and download information. (page 2, "Main View", specifically "Remote File Folders" including filenames such as 'HomePage.zip' and "User Profile")

Claim 33 is rejected since the motivations regarding the obviousness of claim 26 also apply to claim 33.

Regarding claim 34, "Getting Started" and Official Notice discloses the method according to claim 26.

"Getting Started" discloses wherein said first client may display and/or query said database for information related to

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specific file transfers. (page 3, specifically "The 'Uploading' progress page appears and will remain open until the file transfer is completed...")

Regarding claim 35, "Getting Started" and Official Notice disclose the method according to claim 26.

"Getting Started" does not expressly disclose wherein information related to file transfers are recorded and stored in said database via a file identification of said file, however, "Getting Started" does disclose wherein information related to file transfers are recorded and stored via a file identification of said file. (page 2, "Main View", specifically "Remote File Folders" including filenames such as 'HomePage.zip'; page 4, "Sending Files to other Filesanywhere Users or Email Users", specifically "First select a remote file on the left you wish to send. Click Send Files to view the sending options. You will need the FilesAnywhere USERNAME of the intended recipient.")

Claim 35 is rejected since the motivations regarding the obviousness of claim 26 also apply to claim 35.

Regarding claim 36, "Getting Started" and Official Notice disclose the method according to claim 35.

"Getting Started" discloses wherein said file identification comprises at least one of a first client identification, a second client identification, file package



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information, a server site identification, and a download identification. (page 2, "Main View", specifically "Remote File Folders" including filenames such as 'HomePage.zip'; page 4, "Sending Files to other Filesanywhere Users or Email Users", specifically "First select a remote file on the left you wish to send. Click Send Files to view the sending options. You will need the FilesAnywhere USERNAME of the intended recipient.")

Regarding claim 44, "Getting Started" discloses computer readable media having stored thereon a data structure ("server") comprising:

a first field comprising data representing account information of a client; (page 2, "Main View", specifically "Remote File Folders" and "User Profile" and "...the account username and password will be remain on record...")

a second field comprising data representing package information regarding a file for transfer; (page 2, "Main View", specifically "Remote File Folders" including filenames such as 'HomePage.zip'; page 4, "Sending Files to other Filesanywhere Users or Email Users", specifically "First select a remote file on the left you wish to send...E-Send any remote file or local file to other FilesAnywhere users.")

a third field comprising address information for an address to transfer a file; (page 2, "Main View", specifically "Remote

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File Folders" and "User Profile" and "...the account username and password will be remain on record..."; page 4, "Sending Files to other Filesanywhere Users or Email Users", specifically "You will need the FilesAnywhere USERNAME of the intended recipient.")

a sixth field comprising download and/or upload information of a file. (page 4, "Sending Files to other Filesanywhere Users or Email Users", specifically "Click Send Files to view the sending options.")

"Getting Started" does not expressly disclose a fourth field comprising a server site and a fifth field comprising a server list, however, "Getting Started" does disclose wherein a server contains storage as shown above and that the server is accessible through the Internet (page 1, specifically "Login to FilesAnywhere").

Examiner takes Official Notice (see MPEP § 2144.03) that storing a server site and a server list in a Internet accessible server was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d

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724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

2. Claims 23 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Getting Started" in view of "Request for Comments 959" ("RFC 959").

Regarding claim 23, "Getting Started" discloses the method according to claim 2.

"Getting Started" does not expressly disclose wherein said first client software includes file compression, archiving and/or packaging utilities, however, "RFC 959" does disclose

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this limitation (page 23 and 24, section 3.4.3 "Compressed Mode")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "RFC 959" discloses that using file compression utilities to transfer data increases bandwidth for very large network transmissions (page 24, section 3.4.3, specifically "Compressed mode is useful for obtaining increased bandwidth on very large network transmission..."). In view of these specific advantages and that the references are directed to transferring a file over a network, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Regarding claim 37, "Getting Started" discloses the method according to claim 2.

"Getting Started" does not disclose wherein uploading said file may be interrupted and resumed, however, "RFC 959" does disclose this limitation (page 4, specifically "data connection"; pages 24 and 25, section 3.5 "Error Recovery and Restart").

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "RFC 959" discloses that resuming an interrupted transfer of a file protects the receiver from failure of a sender or the network by allowing the resumption of the upload at the marked point agreed upon by the sender and receiver (pages 24 and 25, section 3.5 "Error Recovery and Restart", specifically "...a restart procedure (including failures of a host, and FTP-process, or the underlying network)...In the event of a system failure, the user can restart the data transfer by identifying the marker point with the FTP restart procedure..."). In view of these specific advantages and that the references are directed to transferring a file over a network, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Regarding claim 38, "Getting Started" discloses the method according to claim 8.

"Getting Started" discloses wherein downloading said file may be interrupted and resumed, however, "RFC 959" does disclose

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this limitation (page 4, specifically "data connection"; ; ges 24 and 25, section 3.5 "Error Recovery and Restart").

Claim 38 is rejected since the motivations regarding the obviousness of claim 37 also apply to claim 38.

3. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Getting Started" and "Filesanywhere" as applied to claim 9 above, and further in view of "Request for Comments 959" ("RFC 959").

Regarding claim 24, "Getting Started" and "Filesanywhere" disclose the method according to claim 9.

"Getting Started" and "Filesanywhere" do not disclose wherein said second client software includes file decompression, restoring and/or installing utilities, however, "RFC 959" does disclose this limitation (page 23 and 24, section 3.4.3 "Compressed Mode")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "RFC 959" discloses that using file compression utilities to transfer data increases bandwidth for very large network transmissions (page 24, section 3.4.3, specifically "Compressed mode is useful for obtaining increased bandwidth on very large network transmission..."). In view of these specific advantages and that the references are directed

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to transferring a file over a network, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

4. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Getting Started" in view of US Patent 6 289 012 to Harrington et al.

Regarding claim 39, "Getting Started" discloses the method according to claim 8.

"Getting Started" does not expressly disclose wherein downloading said file from said server may be interrupted, and wherein resumption of downloading said file may be carried out on a second server, however, Harrington does disclose this limitation (column 3, lines 35-58; column 7, lines 40-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Harrington discloses that resuming the transfer of data from another server allows the transfer to continue in case the original server is down (column 3, lines 56-58; column 7, lines 59-63). In view of these specific advantages and that the references are directed to transferring

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a file over a network, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

5. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Getting Started" in view of "Hotmail".

Regarding claim 45, "Getting Started" discloses a graphical user interface (page 2, "FilesAnywhere Main View") for a first client computer system having a selection device, said graphical user interface comprising:

- a user login component for logging a client onto a website for a server; (page 1, specifically "Login to Filesanywhere")

- a client browsing component for browsing the internet; ("web browser")

- a file transfer component for forwarding a file to a second client; (page 2, "FilesAnywhere Main View", specifically "Upload Local File"; page 2 and 3, "Uploading Files To Your FilesAnywhere Drive"; page 4, "Sending Files to other Filesanywhere Users or Email Users")

- a tracking component for retrieving tracking information for tracking said file forwarded to said second client; (page 4,



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specifically "get immediate confirmed delivery of transferred files"); and

an account information component for retrieving account information related to said first client and/or said second client. (page 2, "FilesAnywhere Main View", specifically "User Profile")

"Getting Started" does not disclose an address book component storing and retrieving an address of said second client, however, "Getting Started" does disclose using an address of the second client (page 4, "Sending Files to other FilesAnywhere Users or Email Users", specifically "You will need the FilesAnywhere USERNAME of the intended recipient")

"Hotmail" discloses an address book component storing and retrieving an address of said second client (page 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "Hotmail" discloses that using an address book to store and retrieve an address of a second client enables the user to send a file to a second client of his or her choosing (page 3, specifically "Hotmail has an easy to use function for adding Email addresses to your personal Address Book"). In view of these specific advantages and that the references are directed to using addresses of clients to forward

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files on a website, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art teaches the state of the art in transferring files over a network including using a website to effect the transfer:

- US Patent 5 771 354 to Crawford;
- US Patent 5 790 790 to Smith et al;
- US Patent 6 192 407 to Smith et al;
- US Patent 6 385 655 to Smith et al;
- US Patent 6 415 290 to Botts et al;
- US Patent 6 487 599 to Smith et al;
- US Patent 6 529 956 to Smith et al;
- US Patent 6 584 466 to Serbinis et al;
- US Patent 6 651 166 to Smith et al;
- US Patent 6 714 968 to Prust;
- US Patent 6 732 101 to Cook;
- US Patent 6 351 776 to O'Brien et al;

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US Patent 6 850 911 to Huether;

US Patent Application Publication 2003/0014477 to  
Oppenheimer et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

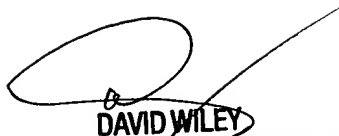
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